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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEH Investments
1652 48th Street
Brooklyn NY 11204

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OFFICE OF PETITIONS

In re Application of	:	
Roth et al.	:	
Application No. 10/655,549	:	ON PETITION
Filed: September 4, 2003	:	
Attorney Docket No. B2745.0028/P0028	:	

This is a decision on the "Petition Under 37 CFR §1.183 To Suspend Patent Regulations", filed on May 20, 2008.

The petition is **DISMISSED**.

Petitioner requests that the Office suspend the rules in effort to ensure that the present application is in compliance with 37 CFR 1.32 (power of attorney), 3.71 (prosecution by the assignee) and 3.73(b) (establishing right of assignee to take action). Petitioner contends that the June 12, 2001 assignment (Reel 011903, Frame 0079) filed in application 08/787,979 of which the current application is a reissue, named an incorrect conveying party.

The assignment named the conveying party as "ORST, INC. (aka Flycast Communication)" the former name of Flycast-CA, when the correct conveying party was "Flycast-DE". The assignment conveyed interest to Engage, Inc ("Engage"). Engage entered into a patent purchase agreement with BEH Investments, LLC ("BEH") which included prior application 08/787,979 now patent 6,285,987. The assignment was recorded on March 31, 2003 (Reel 013895 Frame 0778).

On June 19, 2003, Engage and all of its subsidiaries, including Flycast-DE filed for Chapter 11 Bankruptcy protection. Craig Jalbert was appointed "Liquidating Supervisor" of the consolidated assets of Engage and its subsidiaries. The error in the June 12, 2001 assignment was discovered in May of 2006 by a BEH supervisor. BEH asked the liquidating Supervisor to execute a confirmatory assignment.

The liquidating supervisor executed a confirmatory assignment on June 14, 2006 wherein he acknowledged that patent 6, 285,987 is owned by BEH pursuant to the assigned recorded at Reel 011903, Frame 0079. A second confirmatory assignment was executed in which BEH gave further consideration to Engage. Both confirmatory assignments were recorded with the Office at Reel 018535, frame 0073.

Petitioner insists that justice requires that all of the prior papers submitted be deemed properly signed. Essentially petitioner requests that the Office ratify the prosecution of patent 6,285,987 and the instant application.

APPLICABLE RULES AND REGULATIONS

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

MPEP 301 SECTION V.

A) An assignment can be made of record in the assignment records of the Office. Recordation of the assignment provides legal notice to the public of the assignment. It should be noted that recording of the assignment is merely a ministerial act; it is not an Office determination of the validity of the assignment document nor the effect of the assignment document on the ownership of the patent property. See 37 CFR 3.54 and MPEP § 317.03; and

(B) An assignment can be made of record in the file of a patent application, patent, or other patent proceeding (e.g., reexamination proceeding). This step is necessary to permit the assignee to "take action" in the application, patent, or other patent proceeding under the conditions set forth in 37 CFR 3.73 and MPEP § 324. Recordation of an assignment in the assignment records of the Office does not, by itself, permit the assignee to take action in the application, patent, or other patent proceeding. >For a patent to issue to an assignee, the assignment must have been recorded or filed for recordation in accordance with 37 CFR 3.11. See 37 CFR 3.81(a).<

§ 3.54 EFFECT OF RECORDING .

The recording of a document pursuant to § 3.11 is not a determination by the Office of the validity of the document or the effect that document has on the title to an application, a patent, or a registration. When necessary, the Office will determine what effect a document has, including whether a party has the authority to take an action in a matter pending before the Office.

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MPEP 323 Procedures for Correcting Errors in Recorded Assignment Document

An error in a recorded assignment document will be corrected by Assignment Division provided a "corrective document" is submitted. The "corrective document" must include the following:

- (A) A copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and
- (B) A new Recordation Form Cover Sheet (form PTO-1595) (See MPEP § 302.07). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Corrections may be made on the original assignment document, for example, by lining out an incorrect patent or application number in a merger or change of name (see MPEP §314).

37 CFR 3.73. ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION.

(a) The inventor is presumed to be the owner of a patent application, and any patent that may issue therefrom, unless there is an assignment. The original applicant is presumed to be the owner of a trademark application or registration, unless there is an assignment.

(b)

(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:**>

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). For trademark matters only, the documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office.

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

- (i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or
- (ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

(c) For patent matters only:

- (1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.
- (2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

Pursuant to 37 CFR 3.73(b), a party must be established as the assignee by satisfying the requirements of that subsection, in order to be recognized as an owner or part owner, for purposes of taking action in patent matters before the Office.

Justice does not require that the Office validate all previously filed documents as properly signed. At the filing of this reissue application, petitioner satisfied the requirements of 37 CFR 3.73(b) with the submission of an assignment which was recorded and the submission of a statement pursuant to 37 CFR 3.73(b). This allowed BEH to act as the assignee of record. The Office will not make a determination of the validity of the document or the effect that document has on the title to an application patent or registration.

Petitioner may wish to avail themselves of the provisions of MPEP 323 to correct any errors made in a recorded assignment.

Telephone inquiries regarding this communication should be directed to Charlema Grant at (571) 272-3215.



Anthony Knight
Supervisor
Office of Petitions